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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/081,872 05/20/98 MESSING

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TM02/0313

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EXAMINER

MEISLAHN, D

ART UNIT

PAPER NUMBER

2132

16

DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/081,872

Applicant(s)

Messing

Examiner  
Douglas Meislahn

Group Art Unit  
2132



☒ Responsive to communication(s) filed on Jan 2, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 20-39 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 20-34 and 36-39 is/are rejected.
- ☒ Claim(s) 35 is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): 7
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 02 January 2001 that cancelled claims 1-19, added claims 20-39, amended the title, and altered the specification.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 20-39 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's presentation of commercial success does not form a nexus between the commercial success and the claims; thus it is unpersuasive.
4. For applicant's future benefit, it should be noted that the appearance of unclaimed features in a reference used in a rejection does not constitute a reason for allowance.

### ***Specification***

5. The amendment filed 02 January 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the illustrative example on marked-up page 9 using *a-k* was not present in the original filing.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

6. Claim 35 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See

MPEP § 608.01(n). Accordingly, the claim 35 has not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The final clause of claim 20 says that a client user has signed a document. This is inconsistent with part b3 of the claim, which roughly says that the document is signed by a server system as requested by a signer.

10. In claim 20, clauses a3 and b1-3 all specify providing a means. Since this language does not mandate any action, the clauses are indefinite. They must positively recite the intended limitations. Claim 23 similarly fails to positively recite the claim limitations. Claim 30 suffers from similar deficiencies. Claim 35 must positively recite all of the limitations of claim 20, rather than referencing the claim.

11. Claim 20 recites the limitation "the request" in the second line of clause b3. There is insufficient antecedent basis for this limitation in the claim.

12. Regarding claim 37, the phrase "or other methods" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or other methods"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 20, 21, 24, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ford et al. (Secure Electronic Commerce).

Figure 8.2 of Ford et al. shows an originator sending a document to a trusted third party. This would require establishing the document at the originator (a2) and deciding to send it to the third party, which implies confirming intent to have the document signed. In the paragraph directly below the figure, Ford et al. say that a signature is formed over the document, the identity of the originator, and other data. This immediately anticipates b3. The resultant signature should uniquely identify the user and contains the identity, thus meeting the limitations of b2. It also implies a1 because of the presence of the identity of the originator. In the following paragraph, Ford et al. stipulate that a received document and the sender must be authenticated by the trusted third party. This is a form of access control and thus meets the limitations of b1.

Claim 21 is anticipated because Ford et al. discuss timestamping at the server. Claim 24 is seemingly unrelated to the instant invention, and since speaking a sound is inherently a user action, the claim is anticipated. Ford et al. discuss client signatures in addition to server signatures, thus showing claim 26. Since a human user will

eventually be interfacing with the client through electronic processes, claim 27 is anticipated.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document to a trusted third party who authenticates, signs, and returns the document. They do not say that the authentication requires a biometric or secret. Official notice is taken that authentication by biometric or secret is old and well known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to authenticate the originator of Ford et al. using the common method of either biometric identification or proof of knowledge of a secret.

17. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document to a trusted third party who authenticates, signs, and returns the document. They do not say that an archive of signature identifiers is maintained that is accessible by the trusted third party. Official notice is taken that it is old and well known to archive data that has been used in a

transaction to provide for later clarification of any disputes. It is common to store this data at a neutral third party that is trusted by the parties involved in the transaction.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to record the transaction identifiers of Ford et al. in an archive that is accessible by the trusted third party.

18. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document to a trusted third party who authenticates, signs, and returns the document. They do not say that the signature is a MAC or that the encryption key is a product of the document's unique identifier. Official notice is taken that MACs are old and well known as using symmetric keys to provide something that works as a signature. The keys used to form the MACs can be provided in many ways, including permuting information related to the document to be signed. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use MACs using keys derived from the document to be signed to sign the documents of Ford et al.

19. Claims 25, 30, 32, 34, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document to a trusted third party who authenticates, signs, and returns the document. They do not say that the document includes template information or approval for a credit card transaction. Official notice is taken that online shopping using credit cards is old and well known. In this case, a user

inputs information into a template, such as credit card information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for online transactions in the system of Ford et al.

20. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document that includes template information to a trusted third party who authenticates, signs, and returns the document. They do not say that tags or codes are employed. Official notice is taken that it is old and well known to employ tags with digital signatures to simplify their use. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include tags with the signatures of Ford et al. to make them more practical.

21. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document that includes template information to a trusted third party who authenticates, signs, and returns the document. They do not say that the signature is a MAC or that the encryption key is a product of the document's unique identifier. Official notice is taken that MACs are old and well known as using symmetric keys to provide something that works as a signature. The keys used to form the MACs can be provided in many ways, including permuting information related to the document to be signed. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use MACs using keys derived from the document to be signed to sign the documents of Ford et al.



22. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al.

Ford et al. show an originator sending a document that includes template information to a trusted third party who authenticates, signs, and returns the document. They do not say that the signature is a MAC or that the encryption key is a product of the document's unique identifier. Official notice is taken that MACs are old and well known as using symmetric keys to provide something that works as a signature. The keys used to form the MACs can be provided in many ways, including permuting information related to the document to be signed. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use MACs using keys derived from the document to be signed to sign the documents of Ford et al.

23. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al. as applied to claim 36 above.

Ford et al. show an originator sending a document that includes template information to a trusted third party who authenticates, signs, and returns the document. They do not say that the authentication requires a biometric or secret. Official notice is taken that authentication by biometric or secret is old and well known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to authenticate the originator of Ford et al. using the common method of either biometric identification or proof of knowledge of a secret.

***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9 AM and 6 PM from Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

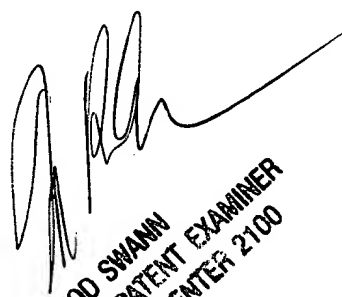
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J. Meislahn  
Examiner  
Art Unit 2132

DJM  
March 12, 2001



TOD SWANN  
SUPERVISORY PATENT EXAMINER  
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